



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/128,753	08/04/98	LIGHTCAP,	D DVL-003PAT

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EXAMINER

PRYOR, A

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

12/26/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/128,753**

Applicant(s)

**Lightcap et al**

Examiner

**Alton Pryor**

Group Art Unit

**1616**



☒ Responsive to communication(s) filed on Nov 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5, 7-13, and 15-47 is/are pending in the application.

Of the above, claim(s) 34 is/are withdrawn from consideration.

☒ Claim(s) 33 and 36-41 is/are allowed.

☒ Claim(s) 1-3, 7, 17, 22, 25-27, 35, and 42-44 is/are rejected.

☒ Claim(s) 4, 5, 8-13, 15, 16, 18-21, 23, 24, 28-32, and 45-47 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Detailed Action**

***Rejections withdrawn***

**I. Rejection of claims 1 and 14 under 35 U.S.C. 102(b) according to JP '236 on record will not be maintained in light of amendment filed 11/27/00.** The specification and claims have been amended to exclude ethanol. Claim 14 has been deleted.

**II. Rejection of claim 15 under 35 U.S.C. 103(a) according to JP '992 on record will not be maintained in light of amendment filed 11/27/00.** The specification and claims have been amended to exclude octyl phenol.

**1. Applicant's arguments filed 11/27/00 have been fully considered but they are not persuasive.**

**I. Rejection of Claims 1-3,7, and 17 under 35 U.S.C. 103(a) according to JP '992 on record will be maintained in light of amendment filed 11/27/00 for reasons on record and as follows:**

Applicant argues that the rejection should be withdrawn for the following reasons:

a) JP '992 discloses that the composition is a detergent. Whereas, the instant application discloses an agricultural composition use to protect plants against frost.

b) JP '992 does not teach the composition comprising a foaming agent.

Whereas, the instant application teaches the instant composition comprising

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a foaming agent. Applicant asserts that it is difficult to provide protection for a plant form freezing temperatures with a stable composition comprising a large percentage of vegetable oil.

Examiner disagrees with applicant for the reason on record and as follows:

- 1) In a claim drawn to a composition, the intended use be it for a detergent or a plant protectant has no patentable weight. In re Maeder et al. 143 USPQ 248.
- 2) Both the prior art composition as well as the instant composition comprise alkyl alcohol ethoxylates (alkyl oxyalkylate). On page 5 lines 2-3 of the instant specification, an alkyl oxyalkylate is defined as an antifoaming agent. Therefore, one having ordinary skill in the art would expect for the prior art composition to have foam. If the large amount of said alkyl is the applicants invention, applicant must show unexpected results - since both the prior art composition and the instant composition are made up of the same chemicals.

**II. Rejection of Claims 1 and 22 under 35 U.S.C. 103(a) according to US '567 will be maintained in light of amendment filed 11/27/00 for reasons on record and as follows:**

Applicant argues that the rejection should be withdrawn for the following reasons:

- a) US '567 does not teach the prior art composition using a foaming agent. Whereas, the instant composition uses a foaming agent.

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- b) US '567 composition does not comprise water. Whereas, the instant composition should be mixed with water.

Examiner disagrees with the applicant for the reasons on record and as follows:

- 1) Both the prior art composition as well as the instant composition comprise alkyl alcohol ethoxylates (alkyl oxyalkylate). On page 5 lines 2-3 of the instant specification, an alkyl oxyalkylate is defined as an antifoaming agent. Therefore, one having ordinary skill in the art would expect for the prior art composition to have foam.
- 2) Neither instant claim 1 nor instant claim 22 list water as a component. Therefore, water does not have to be a component of the instant composition. For these reasons, US '567 reads on claims 1 and 22.

**III. Rejection of Claims 25-27 under 35 U.S.C. 103(a) will be maintained according to JP '992 and JP '097 or US '852 on record for the reasons on record and as follows:**

Applicant argues that the rejection should be withdrawn for the following reasons:

- a) The combination of references do not teach a composition comprising a foaming agent.
- b) It would have not been obvious to one having ordinary skill in the art to combine the references.

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- c) The combination of references do not remedy or solve the problems in the subject application.

Examiner disagrees with the applicant for the reasons on record and as follows:

- 1) Both the prior art composition as well as the instant composition comprise alkyl alcohol ethoxylates (alkyl oxyalkylate). On page 5 lines 2-3 of the instant specification, an alkyl oxyalkylate is defined as an antifoaming agent. Therefore, one having ordinary skill in the art would expect for the prior art composition to have foam.
- 2) It would have indeed been obvious to one having ordinary skill in the art to combine references to arrive at the instant composition. One would have been motivated to do this because all references disclose compositions having the same utility; i.e., all references teach detergent composition. It is obvious to combine 2 or more compositions having the same utility to form a new composition. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)
- 3) In a claim drawn to a composition, the intended use be it for a detergent or a plant protectant has no patentable weight. In re Maeder et al. 143 USPQ 248. Therefore, the problem that the composition solves has no patentable weight in a claim drawn to a composition.

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- 2. Applicant's arguments with respect to claims 35,42-44 have been considered but are moot in view of the new ground(s) of rejection.**

***Claim Rejection under 35 U.S.C. 103(a)***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 35,42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henri et al on record.

Henri et al discloses a method of treating crops with a composition comprising a pesticide, vegetable oil, an emulsifying system, and water. The composition is formulated into an oil-in-water emulsion. See abstract. Henri does not teach the composition comprising a) crude vegetable oil and b) 40-90% vegetable oil. In the absence of unexpected data, the vegetable oil be it crude or pure is not patentable. The claim reads vegetable oil which encompasses pure or crude vegetable oil. With respect to the amount of vegetable oil required, one having ordinary skill in the art at the time the invention was made would have determined the optimum amount of vegetable oil through routine experimentation. One would have been motivated to do this so that the most effective composition would have been developed.

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***Claim Objection / Allowable Subject Matter***

Claim 4,5,8-13,15,16,18-21,23,24,28-32,45-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

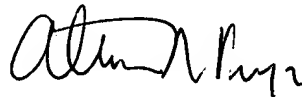
Claims 33,36-41 are allowable. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach a method of preventing the freezing of plants comprising the application of the instant composition to plants.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Acton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Deep, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Alton Pryor

Patent Examiner, AU 1616

12/23/00